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FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO. SERIAL NUMBER 56348 HARVEY 08/30/93 08/113,329 EXAMINER JADVEA 26M1/0420 **ART UNIT** PAPER NUMBER THOMAS J. SCOTT, JR. 10 HOWREY & SIMON 1299 PENNSYLVANIA AVE., N.W. 2602 WASHINGTON, DC 20006 DATE MAILED: 04/20/95 This is a communication from the examiner in charge of your application. COMMISSIONER OF PATENTS AND TRADEMARKS Responsive to communication filed on This application has been examined A shortened statutory period for response to this action is set to expire 3 (Hure) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133 Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION: 1. Notice of References Cited by Examiner, PTO-892. 2. Notice of Draftsman's Patent Drawing Review, PTO-948. Notice of Art Cited by Applicant, PTO-1449. 4. Notice of Informal Patent Application, PTO-152. Information on How to Effect Drawing Changes, PTO-1474... Part II SUMMARY OF ACTION 1. Claims 1-3, 5, 7-11,/3, /6-JOJJJ, 3/-40,43,44, 49-84 are pending in the application. are withdrawn from consideration. 2. 12 Claims 4, 6, 13, 14, 15, 21, 24-30, 41, 45-48
3. Claims 5. Claims _ are subject to restriction or election requirement. 7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes. 8. Formal drawings are required in response to this Office action. 9. The corrected or substitute drawings have been received on _ . Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948). 10. The proposed additional or substitute sheet(s) of drawings, filed on _ , has (have) been approved by the examiner; disapproved by the examiner (see explanation). 11. The proposed drawing correction, filed ____ ____, has been approved; disapproved (see explanation). 12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has 🗆 been received 🗀 not been received ☐ been filed in parent application, serial no. __ __ ; filed on _ 13. Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the ments is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. 14. Other

EXAMINER'S ACTION

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Art Unit: 2602

1. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 uspq 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

2. Claims 1-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, and 49-84 are rejected under the judicially created doctrine of double patenting in view of claims 1-13 of U.S. Patent No. 4,694,490.

The subject matter recited in all of the claims of the present application was fully disclosed in the above identified U.S. Patent as has been explicitly argued by applicant in the second paragraph under the heading "REMARKS" on page 27 of the amendment filed 1/12/95. The allowance of the claims of the

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present application would extend the rights to exclude already granted in claims 1-13 of the U.S. Patent [ie at least for devices/methods encompassed by both sets of claims]. Specifically, the transitional phrase "comprising...A, B, C, and X" [where A,B,C, and X represent means/steps] in the claims of an application in fact extends patent coverage of a patent which claims "comprising...A, B, and Y" [where A,B, and Y are means/steps wherein only A and B are common to both sets of claims] because both claims have overlapping coverage on any method/apparatus which at least "comprises...A, B, C, X, andY".

Thus, the controlling fact is that the patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the application. Furthermore, there is no apparent reason why applicant was prevented from presenting the claims in the application for examination during prosecution of the issued patent.

- The prior art has been cited because it illustrates system which operated to automatically control the broadcast of video programming.
- Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Harvey whose telephone number is (703) 305-4365.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700. David Ellerur D David Ellerur D Exeminer

DEH 4/15/95